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EXAMINER

STRANGE, AARON N

ART UNIT PAPER NUMBER

2153

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/819,244

Applicant(s)

UEDA, SATORU

Examiner

Aaron Strange

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments to the claims overcome the objections raised and several of the 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections. However, some issues remain, as discussed below.

### ***Response to Arguments***

2. Applicant's arguments filed 11/5/2004 have been fully considered but they are not persuasive.

3. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. With regard to claims 1, 7, and 9, and Applicant's general assertion that "Ng fails to teach or suggest the transmission process recited in claim 1" and "charging means perform charging processing" (Page 12, Lines 14-17 of Remarks), the Examiner respectfully disagrees, for the reasons outlined in the rejection of those claims below.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. With regard to claim 2, the functionality of the party button and attorney button is not sufficiently described in the specification. The specification describes that a message is transmitted to the other party communication terminal or the attorney communication terminal responsive to the chosen button. However, the specification fails to specify how the user notifies the party communication terminal which other communication terminal to send the message to. Without having a means of inputting addressing information such as the email of the party and/or attorney to communicate with, the system would be limited to communication between two specific parties with two specific attorneys. Since the preamble of claim 1, from which claim 2 depends, states that there may be "two or more" party and "two or more" attorney communication terminals, the GUI must have means of entering addressing information. No such means is claimed or described in the specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. With regard to independent claims 1, 7, and 9, the claims refer to "the electronic mail" being transmitted between various terminals in several locations. However, it is clear from the specification of the present application that multiple, different messages are being transmitted between the terminals (original; message, comments, reply message, etc)(Page 14-18 of the present application). The Examiner recommends that the claims be amended to reflect that these messages are different and how they are related (i.e. a first electronic mail, a second electronic mail, a reply to said first electronic mail, etc). For the purpose of applying prior art, the messages between each terminal pair have been treated as different message, in accordance with pages 14-18 of the present application.

As best understood by the Examiner, the claimed invention relates to transmission of electronic mail messages between party terminals and attorney terminals wherein each message is authenticated and stored by the communication contents certification apparatus before being forwarded to its ultimate destination. It has been interpreted as such for the purpose of applying prior art.

11. With regard to claim 6, the claim recites a "party identification means" for identifying a communication terminal from which the electronic mail is sent. This language is unclear. A "party identification means" seems to suggest identification of the party sending the message, rather than the communication terminal. Identifying a communication terminal does not identify a party since several parties may use a single communication terminal. The language of the specification suggests that the party identification means identifies the sender of the message, referring to a person (page 14, Lines 16-20 of the present application), and it has been interpreted as such for the purpose of applying prior art.

12. With regard to claim 7, the preamble of the claim states that claim 7 is a "communication contents certification method", but the steps recited are merely a series of messages being transmitted between attorneys and clients. It is unclear how this accomplishes the claimed "communication contents certification method".

13. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-3,5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Abe et al. (US 6,246,991).

16. With regard to claim 1, Ng discloses a communication contents certification system for certifying contents of an electronic mail communicated between two or more party communication terminals through a network, the communication contents certification system comprising:

a communication contents certification apparatus (Email web site) (Fig 4, 20') having communication contents receiving means for receiving said electronic mail (messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), communication contents transmission means for transmitting said electronic mail (Messages are sent through email web site) (Col 6, Lines 42-46), and charging means for charging a fee associated with use of the communication contents certification apparatus (Col 14, Lines 21-26);

a first party communication terminal coupled to the communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58);

a second party communication terminal coupled to the communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58);

wherein

the electronic mail is transmitted from the first party communication terminal to the second party communication terminal such that the electronic mail is routed to the communication contents certification apparatus and the communication contents certification apparatus confirms the authentication information for the electronic mail and stores the contents of the electronic mail (email is sent via the certification apparatus) (Col 8, Lines 19-29),

the charging means perform charge processing to said first and second parties (Col 14, lines 22-26) for use of said communication contents certification means.

Ng fails to specifically disclose first or second attorney communication terminals for communicating with the first and second party terminals via the certification apparatus. However, Ng discloses that the authentication service is available to anyone, since users of the authentication web site (Col 6, Lines 60-61) and users who do not have an account with the authentication service may use it (Col 10, Lines 54-60). Ng further discloses that attorneys could benefit from using the system to verify the authenticity of messages sent via the certification system (Col 13, Lines 62-65). By having impartial certification of email messages, the messages cannot be easily forged and could be submitted as evidence in a court of law. This would be particularly advantageous when a lawsuit is filed regarding a contract agreement such as the one disclosed by Ng in Figures 8A-8D.

Furthermore, Abe teaches providing a privileged e-mail legal advice service so that people may get legal advice from attorneys when preparing documents for storage in a certification apparatus (Col 3, Lines 47-50). The particular order in which messages



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are sent is arbitrary, depending on the type of contract being negotiated, and consulting with an attorney during a contract negotiation is certainly well known. Any particular order would have been apparent to one of ordinary skill in the art, depending on the circumstances at the time the system was being used.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attorney communication terminals use the system to communicate with their clients regarding legal matters such as the contract agreement disclosed in Figures 8A-8D. By having messages certified by time and contents, the attorney and client would have valuable evidence in the event of a lawsuit since the certified emails cannot be easily forged.

17. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Col 8, Lines 20-22), a party button display section for selecting electronic mail communication with the second party communication terminal wherein the first party communication terminal is adapted to transmit the electronic mail as a function of input to the GUI (Clicking on "Authenticated Send" button sends message to second party via certification apparatus)(Col 8, Lines 25-29), it fails to specifically disclose an attorney button display section for selecting electronic mail communication with said first attorney communication terminal.

However, at the time the invention was made, it would have been obvious to one

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of ordinary skill in the art to include an attorney button display because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

18. With regard to claim 3, Ng further discloses that the contents of the electronic mail relate to a contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

19. With regard to claim 5, Ng further discloses that the electronic is encrypted (Col 14, Lines 45-47).

20. Claims 7 and 8 are rejected for the same reasons as claims 1 and 3, since they recite subject matter which is wholly contained within those claims.

21. Claim 9 is rejected for the same reasons as claim 1, since it recites subject matter which is wholly contained within claim 1. Since the system disclosed by Ng is executed on computers, a computer readable recording medium holding the software to perform the method of claim 9 is inherent.

22. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Abe et al. (US 6,246,991) in further view of Zabetian (US 6,327,656).

23. With regard to claim 4, while the system disclosed by Ng and Abe shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the first and second party communication terminals are adapted to transmit reception confirmation information indicating reception of the electronic mail, and the communication contents receiving means receives the reception confirmation information transmitted from the first and second communication terminals, and the communication contents storage means stores the reception confirmation information.

Zabetian teaches a method of confirming the reception of an electronic mail by having the recipient notify the certification requester (the certification apparatus in this case) upon successful receipt of the message. Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site. Either method would provide confirmation that the recipient had received the message. This is advantageous because it can provide proof that the

document was delivered at a certain time, which would be potentially important information when dealing with legal matters.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require confirmation of receipt from the recipient of a certified message, and to store it in the certification apparatus. This would provide proof of the time a message was received by the recipient and track that information in the certification apparatus. Proof of delivery would be very important for certain legal documents, and would be an advantageous addition to the system disclosed by Ng.

24. With regard to claim 6, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the communication contents certification apparatus further comprises party identification means for identifying a communication terminal from which the electronic mail was transmitted.

Ng discloses that the authentication service supports accounts for users of the authentication service. Users with accounts automatically have their messages authenticated (Col 9, Lines 41-45). Zabetian teaches several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3). This provides an additional layer of security that is particularly important for legal matters. By ensuring that the sender of the message is the actual person the message claims to be from, it provides much stronger evidence for use in legal proceedings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a mechanism to verify the identity of a sender of a message. This ensures that the message is actually coming from the person stated in the message header, providing much stronger evidence in regard to legal matters, by greatly reducing the chances that a message is forged.

### ***Conclusion***

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS  
6/14/2005



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